IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Rowlands   Art Unit: 2131

Serial No.: 09/998,234   Confirmation No.: 5084

Filed: December 3, 2001   Examiner: Matthew T. Henning

                                     Docket: TI-29978

For: METHOD OF LOCAL DATA DISTRIBUTION PRESERVING RIGHTS OF A
     REMOTE PARTY

Appeal Brief under 37 C.F.R. §41.37

Board of Patent Appeals and Interferences

United States Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

    This is Appellant's Appeal Brief filed pursuant to 37 C.F.R. §41.37 and the Notice of Appeal filed June 21, 2006 and further in response to the NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF of August 31, 2006.

TABLE OF CONTENTS

Section	Page

Real Party in Interest

The real party in interest in this application is Texas Instruments Incorporated, a corporation of Delaware with its principle place of business in Dallas, Texas. An assignment to Texas Instruments Incorporated is recorded at reel 012344 and frames 0687 and 0688.

Related Appeals and Interferences

There are no appeals of interferences related to this appeal in this application.

Status of the Claims

Claims 1, 3, 4, 7 and 13 are rejected and subject to this appeal. Claims 2, 5, 6, 8 to 12 and 14 to 17 are canceled. No claims are allowed.

Status of Amendments Filed After Final Rejection

No amendments to the claims were proposed following the FINAL REJECTION of March 29, 2006.

Summary of Claimed Subject Matter

This invention is a method of data distribution preserving rights of a remote party. A first embodiment recited in independent claim 1 includes two steps. An authorized user (11) locally transmits data (ENCRYPTED MUSICAL DATA) to a receiver (13, page 2, lines 9 and 10; page 3, lines 22 and 23; page 4, lines 2 and 3, lines 11 and 12; page 6, lines 23 to 25; and page 7, lines 1 to 3) employing a local connection (page 2, lines 28 and 29; page 3, lines 27 to 29; page 7, lines 1 to 3) having a first high bandwidth (page 2, lines 26 to 28; and page 7, lines 1 to 3). Following this local transmission, the receiver (13) authorizes use of the data by a trusted agent (15, page 2, lines 11 to 13; page 3,

lines 1 and 2 and lines 25 to 27; and page 4, lines 3 and 4 and lines 18 and 19) employing a network (page 3, lines 3 to 5) having a second bandwidth less than the first bandwidth (page 3, lines 3 to 5). According to dependent claim 7 the local transmission takes place by directly connecting an apparatus of the authorized user (11) to an apparatus of the receiver (13, page 2, lines 29 to 31; and page 4, lines 22 and 23).

A second embodiment recited in independent claim 3 uses encryption for greater security. The sender (11) chooses an encryption key (K[R]) for use by the receiver (13, page 4, line 7). The sender (11) encrypts the data using this encryption key (page 4, line 8). The sender (11) encrypts the selected encryption key using a public encryption key (KE[TA]) of a trusted agent (15, page 4, lines 9 and 10). The sender (11) locally transmits (page 2, lines 9 and 10; page 3, lines 22 and 23; page 4, lines 2 and 3, lines 11 and 12; page 6, lines 23 to 25; and page 7, lines 1 to 3) both the encrypted data (ENCRYPTED MUSICAL DATA) and the encrypted key (K[R], page 4, lines 11 and 12) to the receiver (13) employing a local connection (page 2, lines 28 and 29; page 3, lines 27 to 29; page 7, lines 1 to 3) having a first high bandwidth (page 2, lines 26 to 28; and page 7, lines 1 to 3). Then the receiver (13) and the trusted agent (15) negotiate licensing and payment for the data (page 2, lines 11 to 13; page 4, lines 14 and 15). The receiver (13) transmits the encrypted key to a trusted agent (15, page 4, lines 16 and 17) employing a network having a second bandwidth less than said first bandwidth (page 3, lines 3 to 5). The trusted agent (15) decrypts the encryption key (page 4, line 18). The trusted agent (15) sends the decrypted encryption key to the receiver (13, page 4, lines 18 and 19) to receive full data access (page, 2, lines 11 and 12; page 3, lines 1 and 2 and lines 25 to 27; page 4, lines 25 to 27) employing the network having a second bandwidth less than the first bandwidth (page 3, lines 3 to

5). According to dependent claim 4, in this second embodiment the receiver (13) optionally chooses a new encryption key (K'[R]) unknown to the sender (11) and encrypts the data with the new encryption key (page 4, lines 20 and 21). According to dependent claim 13 the local transmission takes place by directly connecting an apparatus of the authorized user (11) to an apparatus of the receiver (13, page 2, lines 29 to 31; and page 4, lines 22 and 23).

Grounds for Rejection to be Reviewed on Appeal

(1) Claims 1 and 7 were rejected under 35 U.S.C. 102(e) as anticipated by Saito U.S. Patent No. 6,449,717.

(2) Claims 3, 4 and 13 were rejected under 35 U.S.C. 103(a) as made obvious by the combination of Downs et al U.S. Patent No. 6,574,609 and Saito U.S. Patent No. 6,449,717.

Arguments

Claims 1 and 7 were rejected under 35 U.S.C. 102(e) as anticipated by Saito U.S. Patent No. 6,449,717.

Claim 1 recites subject matter not anticipated by Saito. Claim 1 recites the authorized user locally transmits data "employing a local connection having a first bandwidth" and authorizing the receiver's use of data by a trusted agent "employing a network having a second bandwidth less than said first bandwidth." The ADVISORY ACTION of June 13, 2006 states at paragraph 11, lines 4 to 8:

> "In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. two differing transmissions and two differing connections; using multiple transmission connections; transmitting [anything] over the local connection or the network) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims."

This statement is not understood as the response field May 30, 2006 quoted the relevant recitations in claim 1. The Applicant's argument perhaps inartfully referred to the step of "authorizing the receiver's use of the data by a trusted agent" as a data transmission. This authorizing step is taught in the application as involving a data transmission but claim 1 does not require a data transmission. However, the Examiner has not presented any argument that this authorizing step can take place without a data transmission and the Applicants know of no other method. The arguments in this APPEAL BRIEF will refer to these two steps as transactions to avoid any confusion. The relationship between these two transactions, their connection type and bandwidth is show in Table 1 below.

	Transaction	Connection Type	Bandwidth
First transaction	"an authorized user locally transmitting data to a receiver"	"a local connection"	"a first bandwidth"
Second transaction	"authorizing the receiver's use of the data by a trusted agent"	"a network"	"a second bandwidth less than said first bandwidth"

Table 1

The Response to Arguments section of the FINAL REJECTION states that Saito teaches direct connection and network connection, and by implication teaches the two differing bandwidths recited in claim 1. Even it this is true, Saito fails to teach the subject matter of claim 1. Claim 1 recites two differing transactions and further recites two differing connections and corresponding bandwidths for these transactions. Claim 1 requires that the data transmission step employ "a local connection having a first bandwidth" and that the authorizing the receiver's use of the data step employ "a network having a second bandwidth less than said first bandwidth." Saito fails to teach that the two transactions take place using the two differing connections with the two differing bandwidths as recited in claim 1. These limitations are in accordance with the teaching in this application at page 2, line 25 to page 3, line 5 which state:

> "Copying involves the transfer of large amounts of musical data, making a high-bandwidth data connection desirable. These are inexpensive and common between items of consumer end equipment, but high-speed connections to the Internet are significantly more expensive and rare at this time. This favors highly local communication for the

distribution of the musical data. For example, Alice could connect her portable music player directly to Bob's jukebox to obtain certain music, and this might be more convenient than for Alice to download it from the Internet herself.

"Authorization for use requires communication with a trusted authorizing agent, so inherently requires non-local communication. However it can properly be verified using only small data transfers. Thus authorization may conveniently be transacted using commonly available low-speed wide-area networks, such as the traditional wired or cellular telephone networks."

This portion of the application makes clear that it is advantageous to adopt the differing connections with differing bandwidths for the two transactions.

Saito teaches the two claimed transactions. Saito teaches the two different connection types with their corresponding bandwidths. Claim 1 recites a particular combination of transactions, connections and bandwidths. This particular combination is neither excluded by the teachings of Saito nor emphasized. The Applicant submits that one skilled in the art on consideration of the disclosure of Saito would employ the same connection, either a direct connection or a network connection, for both transmission of the data and the authorization. One skilled in the art would not be motivated to use the two connections disclosed in Saito in the manner recited in claim 1 absent this teaching from this application. Saito includes no teaching of this advantage and no teaching of using the differing connections with differing bandwidths in the manner recited in claim 1. Paragraph 11 of the ADVISORY ACTION states that a rejection under 35 U.S.C. 102(e) requires no motivation. Claim 1 is a method claim. The Applicant respectfully submits that it will often be that a method claim will use known articles and processes in differing combinations or orders than the prior known use. Thus Saito teaches all the parts recited in claim 1 without teaching the particular arrangement of these parts claimed. The Applicant further submits that an off-

hand remark in Saito that requires interpretation to make clear that the claimed subject matter is even feasible fails to anticipate the particular recitations of claim 1.

The ADVISORY ACTION states at paragraph 11, lines 13 and 14:

"Furthermore, it is clearly more feasible for two user computers to be connected directly, than for a user computer to be directly connected to a copyright center."

The Applicant submits that this teaching comes from this application at page 2, line 25 to page 3, line 5 (quoted above) and does not appear in Saito. The Examiner has thus stated that no motivation is needed for a rejection under 35 U.S.C. 102(e), then cites a motivation that appears in the application and not in the reference. This statement of motivation would be proper if it were included in Saito. Such a statement of motivation is improper in this case because it appears only in the application and not in the reference. Accordingly, claim 1 is allowable over Saito.

Claim 7 is allowable by dependent on allowable claim 1.

Claims 3, 4 and 13 were rejected under 35 U.S.C. 103(a) as made obvious by the combination of Downs et al U.S. Patent No. 6,574,609 and Saito U.S. Patent No. 6,449,717.

Claim 3 recites subject matter not made obvious by the combination of Downs et al and Saito. Claim 3 recites "the sender locally transmitting both the encrypted data and the encrypted key to the receiver employing a local connection having a first bandwidth" and both "the receiver transmitting the encrypted key to a trusted agent employing a network having a second bandwidth less than said first bandwidth" and "the trusted agent sending the decrypted encryption key to the receiver to receive the full data employing a network having a second bandwidth less than said first bandwidth." The ADVISORY ACTION includes a statement at paragraph

11, lines 17 to 21 similar to paragraph 11, lines 4 to 8. This statement is not understood as the response filed May 30, 2006 quoted the relevant recitations in claim 3. The Applicant's argument referred to the two transactions as data transmission. Contrary to the case of claim 1, claim 3 clearly states that both transactions are data transmissions. Claim 3 recites the second quoted transaction "the trusted agent sending the decrypted encryption key to the receiver." This limitation is clearly a data transmission as argued in the prior response. The ADVISORY ACTION further states at paragraph 11, lines 21 to 24:

> "The examiner points out that the claims do not specify 'the transmission employing a local connection' of 'the transmission employing a network', but instead recite 'the receiver employing a local connection' and 'a trusted agent employing a network'. As such the examiner does not find the arguments persuasive."

This statement by the Examiner appears a distortion of the language of the response filed May 30, 2005. Table 2 lists the actual language in claim 3, both instances of the language of the response filed May 30, 2006 and the Examiner's understanding as set forth in the ADVISORY ACTION.

Actual language of Claim 3	Language of response filed May 30, 2006 including original quotation marks	Examiner's contention
the sender locally transmitting both the encrypted data and the encrypted key to the receiver employing a local connection having a first bandwidth	(1) the sender locally transmits data "employing a local connection having a first bandwidth" page 5, lines 27 to 29 (2) the data transmission employ "a local connection having a first bandwidth" page 6, lines 4 and 5	the receiver employing a local connection
the trusted agent sending the decrypted encryption key to the receiver to receive the full data employing said network having said second bandwidth less than said first bandwidth	(1) the trusted agent sending to decrypted encryption key to the receiver "employing a network having a second bandwidth less than said first bandwidth." page 5, lines 30 to 32 (2) the authorizing the receiver's use transmission use "a network having a second bandwidth less than said first bandwidth." Page 6, lines 5 to 7	a trusted agent employing a network

Table 2

Regarding the first limitation, the actual claim language and the quotations used in the response filed May 30, 2006 emphasize the data transmission. The Examiner's contention that the limitation should emphasize the receiver is a distortion of the original claim language which makes clear that the data transmission is "to the receiver." The language in the response filed May 30, 2006 pointing out the data transmission and not the destination appears reasonable in light of the actual claim language. Omission of

transmission of the encrypted key seems reasonable in light of the argument presented and is consistent with the actual language. Regarding the second limitation, the phrase "a trusted agent employing a network" does not appear in claim 3. The first reference to the limitation emphasizes the sending the encrypted key. The second reference to this limitation emphasizes the authorization of the receiver. However, both these paraphrases of the actual claim language fairly reflect the claim.

The Response to Arguments section of the FINAL REJECTION states that Saito teaches direct connection and network connection, and by implication teaches the two differing bandwidths recited in claim 3. Even it this is true, Saito fails to teach the subject matter of claim 3. Claim 3 recites two differing transactions and further recites two differing connections and corresponding bandwidths for these transactions. Claim 3 recites a data transmission step "the sender locally transmitting both the encrypted data and the encrypted key to the receiver employing a local connection having a first bandwidth" and further recites "the trusted agent sending the decrypted encryption key to the receiver to receive the full data employing said network having said second bandwidth less than said first bandwidth." Saito fails to teach that the two transactions take place using the two differing connections with the two differing bandwidths as recited in claim 3. These limitations are in accordance with the teaching in this application at page 2, line 25 to page 3, line 5 quoted above. This portion of the application makes clear that it is advantageous to adopt the differing connections with differing bandwidths for the two transactions.

Saito teaches the two claimed transactions. Saito teaches the two different connection types with their corresponding bandwidths. Claim 3 recites a particular combination of transactions, connections and bandwidths. This particular combination is neither

excluded by the teachings of Saito nor emphasized. The Applicant submits that one skilled in the art on consideration of the disclosure of Saito would employ the same connection, either a direct connection or a network connection, for both transmission of the data and the authorization. One skilled in the art would not be motivated to use the two connections disclosed in Saito in the manner recited in claim 3 absent this teaching from this application. Saito includes no teaching of this advantage and no teaching of using the differing connections with differing bandwidths in the manner recited in claim 1. Paragraph 11 of the ADVISORY ACTION states that a rejection under 35 U.S.C. 102(e) requires no motivation. Claim 3 is a method claim. The Applicant respectfully submits that it will often be that a method claim will use known articles and processes in differing combinations or orders than the prior known use. Thus Saito teaches all the parts recited in claim 3 without teaching the particular arrangement of these parts claimed. The Applicant further submits that an off-hand remark in Saito that requires interpretation to make clear that the claimed subject matter is even feasible fails to anticipate the particular recitations of claim 3.

Regarding claim 3 the ADVISORY ACTION includes a statement at paragraph 11, lines 28 and 29 similar to paragraph 11, lines 13 and 14 quoted above. The Applicant submits that this teaching comes from this application at page 2, line 25 to page 3, line 5 (quoted above) and does not appear in Saito. The Examiner has thus stated that no motivation is needed for a rejection under 35 U.S.C. 102(e), then cites a motivation that appears in the application and not in the reference. This statement of motivation would be proper if it were included in Saito. Such a statement of motivation is improper in this case because it appears only in the application and not in the reference. The FINAL REJECTION includes no allegation that Downs et al makes obvious these limitations.

Accordingly, claim 3 is allowable over the combination of Downs et al and Saito.

Claims 4 and 13 are allowable by dependence upon allowable claim 3.

If the Examiner has any questions or other correspondence regarding this application, Applicants request that the Examiner contact Applicants' attorney at the below listed telephone number and address to facilitate prosecution.

Texas Instruments Incorporated   Respectfully submitted,
P.O. Box 655474 M/S 3999
Dallas, Texas 75265
(972) 917-5290
Fax: (972) 917-4418   /Robert D. Marshall, Jr./
                           Robert D. Marshall, Jr.
                           Reg. No. 28,527

CLAIMS APPENDIX

1   1.   A method of data distribution preserving rights of a
2 remote party comprising the steps of:
3   an authorized user locally transmitting data to a receiver
4 employing a local connection having a first bandwidth; and
5   following said locally transmitting step, authorizing the
6 receiver's use of the data by a trusted agent employing a network
7 having a second bandwidth less than said first bandwidth.

1   3.   A method of data distribution preserving rights of a
2 remote party comprising the steps of:
3   a sender choosing an encryption key for a receiver's use;
4   the sender encrypting the data using the encryption key;
5   the sender encrypting the encryption key using a public
6 encryption key of a trusted agent;
7   the sender locally transmitting both the encrypted data and
8 the encrypted key to the receiver employing a local connection
9 having a first bandwidth;
10   following said locally transmitting step, the receiver and the
11 trusted agent negotiating licensing and payment for the data;
12   following said locally transmitting step, the receiver
13 transmitting the encrypted key to a trusted agent employing a
14 network having a second bandwidth less than said first bandwidth;
15   following said locally transmitting step, the trusted agent
16 decrypting the encryption key; and
17   following said locally transmitting step, the trusted agent
18 sending the decrypted encryption key to the receiver to receive the
19 full data employing said network having said second bandwidth less
20 than said first bandwidth.

1   4.   The method of Claim 3 including the further step of;

2   the receiver choosing a new encryption key unknown to the

3   sender and encrypting the data with the new encryption key.

1   7.   The method of Claim 1, wherein:

2   said step of locally transmitting data includes directly

3   connecting an apparatus of the authorized user to an apparatus of

4   the receiver.

1   13. The method of Claim 3, wherein:

2   said step of locally transmitting both the encrypted data and

3   the encrypted key includes directly connecting an apparatus of the

4   sender to an apparatus of the receiver.

Evidence Appendix

None

Related Proceedings Appendix

None